I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: May 8, 2006 Signature: (Lynn L. Janulis, Ph.D.)

Docket No.: 01017/35966C (PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Han et al.

Application No.: 10/758,636 Group Art Unit: 1652

Filed: January 15, 2004 Examiner: E. Slobodyansky

For: The Human E3α Ubiquitin Ligase Family

ELECTION WITH TRAVERSE IN RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement imposed in the Office Action mailed November 14, 2005 (the "Office Action"), the applicants hereby elect Group I (drawn to an isolated polynucleotide, vectors and host cells comprising that polynucleotide, and methods of using said host cells in producing polypeptides), with traverse, for prosecution on the merits at this time. This election is timely filed along with a petition for an extension of time and the requisite fee.

There would be no serious search burden on the examiner if Groups I and II were examined simultaneously. M.P.E.P. §803 provides:

> If the search and examination of an application can be made without serious burden, the Examiner **must** examine it on the merits, even though it includes claims to distinct or independent inventions. (*Emphasis added.*)

Thus, for a restriction to be proper, the examiner must satisfy the following two criteria: (1) that independent and distinct inventions are being claimed (35 U.S.C. §121); and (2) that the search and examination of the entire application cannot be made without serious burden. See M.P.E.P. §803.

The examiner asserted that the products of Group I can be used in any of the methods of Group II as well as for the production of a huE3α polypeptide in a method of Group I and, therefore, Groups I and II are related as products and process of use. Office Action at page 3. However, the examiner has not established that a serious burden would be imposed on the Patent Office if all claims under consideration were searched and examined together. The claims under consideration define subject matter that directly or indirectly relates to biomolecules of defined sequences, which are searched using electronic databases and do not primarily rely on the classifications identified in the Office Action. The results of these searches contribute to the shape of the examination. The claims of Groups I and II are structurally related by the polynucleotide of SEQ ID NO: 3 (Group I) and its encoded polypeptide of SEQ ID NO: 4. Any search designed to identify art relevant to the patentability of the claimed polynucleotides, vectors, host cells, and methods of producing the encoded polypeptides of Group I (claims 1-8, 10, 11, 46-48, 59, and 60) would also uncover art relevant to the methods of Group II (claims 61-64). The applicants respectfully submit that the methods of Group II all involve the polynucleotide of SEQ ID NO: 3 of Group I and, therefore, there would be no serious burden on the examiner to search these methods as they relate to the polynucleotide of SEQ ID NO: 3.

In light of the above comments and in view of the subject matters of the claims under consideration, the applicants submit that the examiner has failed to establish that a serious burden would be imposed if all of these claims were searched and examined in the instant application. Accordingly, the applicants submit that the restriction requirement has been overcome and should be withdrawn.

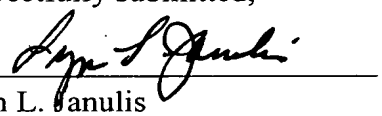
CONCLUSION

For the foregoing reasons, the applicants request reconsideration and withdrawal of the restriction requirement. Should the examiner have any questions or comments regarding this response or the application, the examiner is invited to contact the undersigned at the number indicated.

If the restriction requirement is not withdrawn, however, Applicants hereby request that the Patent Office rejoin the method claims of Group II if the product claims of Group I are allowed. *See* M.P.E.P. §821.04.

Dated: May 8, 2006

Respectfully submitted,

By 

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